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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/799,274 | 03/12/2004 | Quin Winford | C04049US (98885.1C) | 7234 |

22920 7590 09/20/2004

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| EXAMINER |
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
STASHICK, ANTHONY D

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| ART UNIT | PAPER NUMBER |
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3728

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/799,274 | Applicant(s) QUIN WINFORD ET AL.  | |
| | Examiner Anthony Stashick | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20 is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 2-5,9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by either one of Bazzle et al. 4,130,950 or Kim 4,771,556.

Bazzle et al. '950 discloses all the limitations of the claim including the following: a shoe having first and second lateral sides (sides of the upper and sole of the shoe pictured in Figure 1) and a bottom (bottom of the sole where spikes 11 protrude); at least one disc 23; the at least one disc being operatively connected to the first lateral side (by magnet 14) and above the bottom (see Figure 1) so that the disc will not engage a walking surface; the at least one disc being rotatable with respect to the shoe (the disc can be placed on the magnet and rotated).

Kim '556 discloses all the limitations of the claim including the following: a shoe having first and second lateral sides (see Figures, lateral sides are sides of the shoe upper and sole) and a bottom (bottom of sole that contacts the ground); at least one disc (3); the at least one disc being operatively connected to the first lateral side (see Figures) and above the bottom (does not allow for contact of disc with the ground) so that the disc will not engage a walking surface; the at least one disc (3) being rotatable with respect to the shoe (disc can be rotated when placed within the shoe).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of the references as applied to claim 1 above in view of Spector 5,996,253 or Moumdjian 5,295,314.

The references as applied to claim 1 above disclose all the limitations of the claim except for the bottom having a sole with an inflatable chamber and pumping port. Spector '253 and Moumdjian '314 are each examples of shoes that have a sole with a chamber and pumping port that allows for the chamber to be inflated to the desired pressure to perform the desired cushioning of the impact of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a chamber with an attached pumping port, in the sole of either one of the references as applied to claim 1 above, to give the user the ability to adjust the cushionability of the shoe for personal comfort.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of the references as applied to claim 1 above. The references as applied to claim 1 above disclose all the limitations of the claims except for multiple discs and the discs being of different designs. Showing that the disc of Bazzle et al. '950 is different than that of Kim '556, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make discs of different designs to allow for the user to choose what they wanted to display with each disc being interchangeable with the other.

Art Unit: 3728

Allowable Subject Matter

6. Claims 11-20 are allowed over the prior art of record.
7. Claims 2-5 and 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is (703) 308-3876. The examiner can normally be reached on Monday through Thursday from 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony Stashick

Application/Control Number: 10/799,274

Page 5

Art Unit: 3728

Primary Examiner
Art Unit 3728

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